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PTO/SB/21(09-04)
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/722,553	
	Filing Date	November 28, 2003	
	First Named Inventor	Hajime Nakagawa	
	Art Unit	1752	
	Examiner Name	CHEA, THORL	
Total Number of Pages in This Submission	8	Attorney Docket Number	FS-F03214-01

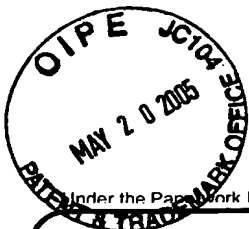
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<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> After Allowance Communication to TC
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Taiyo, Nakajima & Kato		
Signature	<i>Sheldon J. Moss</i>		
Printed name	Sheldon J. Moss		
Date	May 18, 2005	Reg. No.	52,053

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PTO/SB/17 (12-04v2)

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005**Complete if Known**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 130.00

Application Number	10/722,553
Filing Date	November 28, 2003
First Named Inventor	Hajime Nakagawa
Examiner Name	CHEA, THORL
Art Unit	1752
Attorney Docket No.	FS-F03214-01

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 501322 Deposit Account Name: TAIYO, NAKAJIMA & KATO

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.****FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Statutory disclaimer 130.00**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	52,053	Telephone	703-416-0376
Name (Print/Type)	Sheldon J. Moss	Date	May 18, 2005		

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**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)

FS-F03214-01

In re Application of:

Application No.: 10/722,553

Filed: November 28, 2003

For: PHOTOTHERMOGRAPHIC MATERIAL

FUJI PHOTO FILM CO., LTD.

The owner*, _____, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/724,706, filed on December 2, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that: any such patent: granted on the pending reference application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 52053

Signature

May 18, 2005

Date

Sheldon J. Moss

Typed or printed name

703-416-0376

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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05/24/2005 JADD01 00000008 501322 10722553

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
Hajime Nakagawa et al.

Appln. No.: 10/722,553

Confirmation No.: 8306

Filed: November 28, 2003

For: **PHOTOTHERMOGRAPHIC MATERIAL**

Docket No: FS-F03214-01

Group Art Unit: 1752

Examiner: Thorl Chea

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

I. Response to Claim Rejection under 35 U.S.C. §103

A. Fukui et al. and Tsuji

Claims 1 and 3-15 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Fukui et al. and Tsuji.

Applicants respectfully submit that the combination of Fukui et al. and Tsuji does not disclose the photothermographic material of the claimed invention. The Examiner has admitted that Fukui et al. does not disclose the polymer disclosed in the claimed invention. In order to cure the deficiency, the Examiner has relied on the disclosure of Tsuji. The Examiner states:

"it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer latex containing the butadiene group taught in Fukui et al. including the use of the substituents known in the formation of latex taught in Tsuji with a reasonable expectation of achieving a binder with good quality such as providing the material development uniformity and rapid image form,

and thereby provide an invention as claimed."

Applicant respectfully disagrees. Tsuji does not teach what effects are produced by the methyl groups on polymer II-1 to II-9 disclosed in columns 9 and 10 of Tsuji. Column 7, lines 14 to 10 of Tsuji recites "at least one of R_1 through R_6 is $-SO_3X$." This suggests that the $-SO_3X$ group is essential for achieving the expected functions of the polymer of Formula (II) used in Tsuji. The importance of $-SO_3X$ group is in consistent with the antistatic characteristic imparted by the polymer of Tsuji. In contrast, an alkyl group such as a methyl group is not considered essential since Formula (II) includes a formula in which at least one of R_1 through R_6 is $-SO_3X$ and the remainder is hydrogen atoms. Accordingly, a person skilled in the art would not think the methyl groups on polymers II-1 to II-9 have a function of providing the material development uniformity and rapid image formation. Consequently, a person skilled in the art would not be motivated to add the methyl group taught in Tsuji to the polymer taught in Fukui.

Further, Tsuji has little technical relation to the field of a photothermographic material. The disclosure of Tsuji is involves a conventional photosensitive material which is developed with a liquid developer (column 14, lines 60-64 of Tsuji). The invention of Tsuji achieves even development upon development with a liquid developer in the presence of a nonionic surfactant (column 1, lines 40-50). In contrast, the photothermographic material of the invention is thermally developed. Since the

development process is different, development evenness (upon development with a liquid developer) achieved in Tsuji does not have a technical relationship with the present invention. The present invention provides a photothermographic material with high sensitivity and image storability as demonstrated in the Examples of the present Specification. Such effects are neither taught nor suggested in Tsuji. Accordingly, a person skilled in the art would not be motivated to use the substituents disclosed in Tsuji for achieving the effects of the present invention, which are not taught in Tsuji.

Moreover, as described in column 21, lines 38-39 and Table 1 of Tsuji, the latex of Tsuji is used as an additive in an amount of 20 % by mass at most in the protective layer, and in an amount of 10 % by mass at most in the emulsion layer. However, as described in claims 1, 13, and 16 of the present application, the polymer of the present invention is used as the binder. Accordingly, a person would not expect the effect achieved by the present invention based on the disclosure of Tsuji because the polymer is used in different ways.

Because the combination of Fukui et al. and Tsuji does not teach nor suggest the photothermographic material of the present invention, withdrawal of the rejection is respectfully requested.

B. Fukui et al. and Tsuji, in view of either Ezoe or Goto

Claim 2 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over

Fukui et al. and Tsuji, in view of either Ezoe or Goto Ohzeki et al. The withdrawal of the rejection is respectfully requested for the reasons set out above because of its dependency.

C. Fukui et al., Tsuji, and Encyclopedia of Chemical Technology, Forth Edition

Claims 16-21 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Fukui et al., Tsuji, and Encyclopedia of Chemical Technology, Forth Edition. The Examiner has relied on the combination of Fukui et al. and Tsuji for explaining how a person in the art would be motivated to use the polymer of the invention. However, the combination of Fukui et al. and Tsuji neither teaches nor suggests the polymer of the invention as described in the above item A. The Encyclopedia of Chemical Technology, Fourth Edition, cannot cure the deficiency since it does not teach the polymer of the invention. Therefore, the combination of Fukui et al., Tsuji, and Encyclopedia of Chemical Technology, Fourth Edition neither teaches nor suggests the presently claimed invention.

Accordingly, withdrawal of the rejection is respectfully requested.

II. Response to Provisional Double Patenting Rejections

A. Copending Application No. 10/724,706

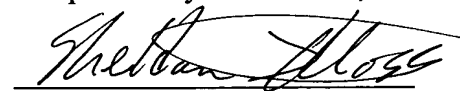
Claims 1 and 3-13 have been rejected under obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/724,706 in view of Fukui et al. Although Applicant does not agree with the rejection, Applicant hereby submits a Terminal Disclaimer with respect to Application 10/724,706. Accordingly, the rejection has been overcome.

B. Copending Application No. 10/724,706

Claims 13-21 have been rejected under obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/724,706. Although Applicant does not agree with the rejection, Applicant hereby submits a Terminal Disclaimer with respect to Application 10/724,706. Accordingly, the rejection has been overcome.

In view of the foregoing remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



TAIYO, NAKAJIMA & KATO
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Date: May 18, 2005

Sheldon J. Moss
Registration No. 52,053